



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application:

JEFFREY J. NORMAN : May 4, 2005

Serial No.: 09/912,289 : Art Unit: 3673

Filed: 07/24/01 : Examiner: SUNIL SINGH

For: UNDERGROUND WATER RETENTION APPARATUS

**REQUEST FOR RECONSIDERATION**

Hon. Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Sir:

This Request for Reconsideration is in response to the Office Action dated November 17, 2004.

The allowance of claims 28-30 and 32, and the allowability of claims 5-12 and 25-26 is duly noted.

The rejection of independent claim 31 and its dependant claims 2-3,13-15, and 17-24 on multiple grounds and references is also noted and traversed. The traverse of the rejected claims on the Scoville, Whitfield, and Jordan references has been adequately

discussed in prior amendments and Appeal brief. It is again respectfully suggested that the Examiner is in error in his analysis of both the subject matter of the present invention and the applicability of the three primary references.

The Examiner states that nothing in the claims precludes the small floor drain of Scoville, the small plastic element of Whitfield, or the upflow filter of Jordan from meeting the limitations of the claims. However, it is axiomatic that the claims must be read in view of the specification. Clearly, the specification, in describing the various elements which comprise the present invention, does not contemplate such elements as are noted in the cited references. Rather, the present apparatus comprises a water retention basin usable, for example, for a shopping center, where the appropriate use for the roof means is for parking vehicles.

Could vehicles be parked on the top of Scoville, Whitfield, or Jordan? Of course not! Moreover, the Examiner must use a single element from the cited references for more than one element of the present independent claim 31.

The term “perimeter” as used in the present specification has been adequately discussed in previous submissions. No where in the specification has the term “perimeter” been used in the manner as interpreted by the Examiner. In the Examiner’s rebuttal, he cites Figures 7, 8, and 9, and the caissons therein. However, the attention of the Examiner is respectfully directed to page 12, paragraph 0037 in which the L-beams are specifically defined as the perimeter support means. The caissons support the L-

beams, but the caissons by themselves do not comprise the perimeter support means. Note that the L-beams extend about the entire periphery of the apparatus of Figs. 7, 8, and 9. Whitfield does not have any structure to compare to the perimeter support means of the present invention, as clearly defined in claim 31.

Similarly, the Jordan apparatus as interpreted by the Examiner does not have a perimeter support element which meets the structural definitions found in the specification and in claim 31.

If the side and end walls of Scoville comprise the perimeter support elements comparable to the structure recited in claim 31, then part of the perimeter support must be arbitrarily separated to comprise, with the bottom, to meet the water retention means. That interpretation is erroneous. Nowhere in the present specification, in the drawings, or in claim 31 is there any such comparable structure. Each of the five elements or "means" found in claim 31 stands by itself. There is no arbitrary division of an element into two elements.

With respect to the rejections of claims 19, 20, 21, 22, 23, and 24, it is not clear how the Examiner divides up the retaining wall for the retention means, and then the relatively short and relatively long portions of the wall. On the other hand, there is no arbitrary apportioning of the present invention because the drawing figures and the specification are clear as to the claimed structure.

Moreover, there is no structure in Scoville that compares to the structure of claims 23 and 24. It is respectfully submitted that the Examiner's analysis is totally without merit.

The Examiner states that the top member of Whitfield sits on the corner posts along the perimeter. The top sits on the four corner posts only at four places, not along the entire perimeter of the top. Moreover, the four corner posts do not extend fully along the perimeter of the Whitfield structure. The top element also sits on the top of the side walls. However, again, the Examiner must use the side walls for both perimeter support means, along with the corner posts, as well as use the side walls, the corner posts and the bottom for the retention means. Multiple uses of the same elements! No!! Nothing in the present application allows such interpretation.

The Examiner asks where in claim 31 does it say that the support means is separate from the holding means. The answer is very simple: two different means are defined in the claim, and the two different means are shown in the drawing figures and are discussed in the specification. Nothing in the drawing figures, the specification, or the claims indicate that a single element may be used as two different means to perform two different functions!

The Examiner apparently considers that physical resemblance between the present invention and the cited references is immaterial. However, it is again respectfully submitted that under 35 U.S.C. §102(b) the cited reference should at least physically

resemble in some way the claimed structure. The claimed structure recited in claim 31 does not in any way resemble the structure of Scoville, the structure of Jordan, or the structure of Whitfield. And vice versa, nothing in the structure of Scoville, Jordan, or Whitfield resembles the claimed structure. The reason is obvious: The present invention has a completely different purpose than those of the cited references, and one would logically conclude that the structures would be accordingly different.

The Examiner takes portions of Jordan apart from the structure as a whole in order to reject the present invention. Once again, the structure and function of Jordan is completely immaterial with respect to the invention described in the specification, clearly shown in the drawing figures, and clearly and simply defined in independent claim 31. Jordan does not include in its complicated structure anything comparable to the five elements defined in claim 31. Again, the reason is obvious: Jordan's structure is for a completely different purpose from that of the present invention.

Finally, the present structure is defined as "underground water retention apparatus." The Scoville and Whitfield structures may more nearly correctly be referred to as "in ground apparatus." They clearly not "underground" as the term is used for the present invention.

The Zimmerman structure has also been previously discussed. It merely shows a submersible pump in a well adjacent to a basement. Combining Zimmerman's pump with either or both Scoville and Whitfield is completely unwarranted. And to add a

submersible pump to the Jordan structure would clearly defeat the purpose of the Jordan structure.

For the reasons given above, it is respectfully submitted that independent claim 31 defines over the art of record and is accordingly allowable. It follows that its dependent claims are also allowable. An indication of such allowability is respectfully urged.

All of the claims in the present application are found in the following Appendix.

Respectfully submitted,

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